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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,211	12/19/2001	Douglas E. Clark	3156.1000-002	5174

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ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/07/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,211

Applicant(s)

CLARK ET AL.

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,13-18,20,21,23-32,37-39,41,51 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-12,19,22,33-36,40,42-50 and 52-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claims 2,3,13-18,20-21,23-32,37-39,41,51,58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11. Claims 20-21, 23-32 and 37-39 have been included above. As applicant explains claims 20-21 are shown in figure 27B (a non-elected embodiment) and claims 23 and 37 as now amended (i.e. "tailored zones joined by a transition zone comprising material from each adjacent one of the tailored zones" read on the embodiment shown in figure 15E and 15F (a non-elected embodiment)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,4-10,12,40,42-46,48,49,50,52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6519876 (Geer et al).

Geer teaches a shoe with expansion mechanisms (see col. 29, line 65 to col. 31, line 30) substantially as claimed including a bottom (the outsole as best shown in figures 76 and 77) having an expansion mechanism (7500, 7600, 7602) having a plurality of slots (best shown in figure 72A) extending laterally and longitudinally, an upper (see figures 70 and 72) having expansion mechanism (7004, 7102) wherein mechanism 7102 has a plurality of slots (best shown in figure 72A), a chassis (midsole) having an upper contoured surface (see figure 2), a heel cup (see figure 2) and at least three tailors zones. Geer teaches a number of different embodiments of midsole, each of the midsoles extends under the entire foot and therefore have at least three zones (i.e. the heel, the metatarsal and the toe) as claimed. Moreover, the midsole as shown and described in figure 13 and col. 15, line 64 to col. 16, line 6 can have inserts (zones) provided for the heel, shank (arch), and forefoot (toes) areas. Regarding claims 6 and 43, Geer teaches the upper can be made out of leather (see col. 10, lines 20-28), and see figure 70 which shows flexible material (7004) interposed between two pieces of the upper (leather upper) at a seam (stitching as shown in figure 70). Regarding claims 7 and 44, the seam is inherently an omega seam. Regarding the waterproof, breathable liner, Geer teaches these features, see col. 10, lines 30-39, col. 23, lines 48-51 and col. 24, line 66 to col. 25, line 5. Regarding claims 50 and 57, see figure 72A which show the grooves/slots angles outwardly. When a foot is placed within the shoe the expansion mechanism will inherently expand laterally in response to a downward force, especially when the foot is larger than the interior volume of the shoe.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 19, 22 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geer in view of US 5566475 (Donnadieu).

Geer teaches a shoe substantially as claimed (see the rejection above) except for a liner having an expandable region and a non-expandable region. Geer teaches the upper may have other layers of materials that are waterproof and breathable and therefore teaches providing a waterproof liner, see col. 10, lines 20-39. Donnadieu teaches a liner for a shoe comprising an expandable region in the metatarsal and toe zones (11) and a non-expandable region in the heel zone (13), see col. 4, lines 34-35. It would have been obvious to provide the shoe of Geer with a liner having a stretchable and non-stretchable zones, as taught by Donnadieu, to ensure good heel retention. When a foot is placed within the shoe the expansion mechanism will inherently expand laterally in response to a downward force, especially when the foot is larger than the interior volume of the shoe.

6. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sacre '810 in view of US 5566475 (Donnadieu).

Sacre teaches a shoe substantially as claimed including a bottom (12), an upper (10), a chassis (14), a waterproof breathable liner (32) and a waterproof gasket (55)

substantially as claimed except for a liner having at least one stretchable region.

Donnadieu teaches a liner for a shoe comprising an expandable region in the metatarsal and toe zones (11) and a non-expandable region in the heel zone (13), see col. 4, lines 34-35. It would have been obvious to provide the shoe of Sacre with a liner having a stretchable region, as taught by Donnadieu, to ensure good heel retention. Regarding the terms "slip-lasted" and "cement lasted", the method of forming the device (i.e. slip lasted and cement lasted) is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. It is well settled that the patentability of a product ordinarily cannot depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985).

Response to Arguments

7. Applicant's arguments filed Oct. 22, 2003 have been fully considered but they are not persuasive.

Applicant argues Geer's expansion mechanism doesn't expand laterally in response to a downward force.

To the contrary, when a foot is placed within the shoe of Geer the expansion mechanism will inherently expand laterally in response to a downward force, especially when the foot is larger than the interior volume of the shoe.

Applicant argues "Neither the Donnadieu reference nor the Geer patent teaches or suggest a waterproof, breathable liner with the claimed expandable and non-expandable regions".

In response, Geer teaches a waterproof breathable liner, see the rejection above and Donnadiu teaches a liner with expandable and non-expandable regions.

Applicant argues Donnadiu is directed to a ski boot or a skating boot and is not considered analogous prior art.

To the contrary, the invention of Donnadiu is in the footwear art. Moreover, Donnadiu is being combined with Geer and not applicant's invention. Geer is directed to ski boots and skating boots, see col. 9, lines 1-6.

Applicant's request for an interview has been noted but since the examiner, presently, doesn't have any suggestions for amending the claims in order to put them in condition for allowance an interview hasn't been initiated, see MPEP 713.01.

8. Applicant's arguments with respect to claim 47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov .

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM.

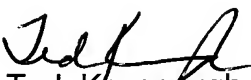
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Other helpful telephone numbers are listed for applicant's benefit.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
November 6, 2003